

REMARKS

In response to the final Office Action dated November 28, 2005, Applicants are submitting a Request for Continued Examination (RCE) with a preliminary amendment for the Examiner's continued consideration. By this preliminary amendment, Applicants have amended the claims and presented arguments that distinguish those claims from the prior art.

On page 2 of the office action, the Examiner rejected claims 1, 2, 4, 6, 9-11, 14, 15, 24, and 28-33 under 35 U.S.C. Section 103(a) as unpatentable over Kanamori et al ("Kanamori") in view of Tran et al. ("Tran"). On page 5, the Examiner rejected claims 3, 5, 7, 8, 12, and 13 under 35 U.S.C. Section 103(a) as being unpatentable over Kanamori in view of Tran and further in view of Kim. Also, with respect to specific aspects of the claims, the Examiner has taken Official Notice. The Examiner has relied on Kim only for its teaching of a flash memory.

With regard to Claim 1, the Examiner alleges that Kanamori teaches a main control unit 111, having programmed rules for determining the volume of first and second audio sources (a talking voice signal and music) and demonstrates a priority system based on the presence of the first and second audio sources. The Examiner acknowledges that "[w]hile Kanamori discloses priority levels as a function of the source of the first and second audio signals, the reference does not teach assigning priority levels as a function of a nature of the output device. For this aspect, the Examiner relies on Tran.

Tran discloses a multimedia speaker detection circuit comprising speaker detection 64, which is able to distinguish between actively driven and passively driven speakers attached to computer system 12. The Examiner contends that as shown in Figure 4, the level of amplification of the outgoing audio is based on the detected impedance level of the attached speakers. Therefore, it was recognized in the art to assign priority levels in an audio system according to the nature of the output device (type of speaker). Thus, the Examiner believes that it would have been obvious to one of ordinary skill in the art at the time of the invention, to add a priority level based on the type of audio output device, as taught by Tran, in the invention of Kanamori for the purpose of maximizing the audio output without overdriving the speakers.

Applicants respectfully assert that the mode of operation of the phone in Kanamori (e.g., operating in a telephone communication mode or a music player mode) is clearly not equivalent to the nature of the output device (e.g., headphone or speaker, at page 18, lines 1-8). On page 2

of the office action, the Examiner contends that Applicants' assertion has no relevance with regard to the rejection. The Examiner further explains that the rejection is based on a combination and that Kanamori discloses that priority levels are established based on the mode of operation of the phone and that the modes of operation of the phone correspond to the different (multiple) audio sources. From that the Examiner makes a leap that the priority levels are established as a function of audio signal sources. The Examiner believes that it would have been obvious to one of ordinary skill in the art at the time of invention to combine the references because taking account of the nature of the output device allows the handheld device to amplify the audio signals appropriately.

The Examiner's reasoning would not have been so obvious to one of ordinary skill in the art. for the following reasons. Kanamori only discloses adjusting the volume as a function of the source of the audio signals (e.g., telephone communication source or music player source). The claims clearly recite that the assigning of priority levels is a function of both the source of the audio signals and the nature of the output device upon which the audio signals will be rendered. Applicants respectfully contend that the type of speaker (whether active or passive) does not satisfy the recitation requiring the "nature of the output device." Moreover, there is no motivation in Kanarnori that invites a combination with Tran as suggested by the Examiner because Tran discloses a multimedia speaker detection circuit for a computer system, that is, in a desk top environment.

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03 To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references (Kanamori and Tran) that meets the claimed limitations, but must also point to the motivation in the asserted references (Kanamori and Tran) that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the

vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An Examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerisonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Claims 2- 13 and 31 are dependent upon independent claim 1, and incorporate all the limitations of claim 1. Hence, claims 2- 13 and 31 are patentable over Kanamori for at least the same reasons urged in support of claim 1. Moreover, the claims (e.g. claim 24) recite other limitations such as sensing the presence and amplitude of each audio signal generated by a plurality of audio signals, which aspects are not found in Kanamori. Applicants respectfully request the Examiner to withdraw the rejection of Claims 1 - 13 and 31.

Regarding Claim 14, the Examiner alleges that Kanamori discloses that the main control unit established a priority for the first and second audio sources based on their presence and output signals (which is based on the mode of the phone, the output signals being a ring tone or music or voice). The Examiner also alleges that the ring tone has a higher priority than the music signal since the signal is lowered in volume or the ring tone is increased in volume so that the ring tone can be recognized by the user. The Examiner further alleges that one of the audio

sources is adjusted in level and the sources are combined in a mixer. However, Applicants respectfully assert that to the extent that Kanamori may teach or suggest establishing a priority for each possible pairing of a plurality of audio signals as a function of a source of each of said plurality of audio signals, Kanamori does not disclose adjusting a first and second one of the plurality of audio signals according to a nature of an output device utilized for rendering a resultant audible output signal and a first priority corresponding to the first and second one of the plurality of audio signals. The Examiner has rejected claim 14 and other claims in view of a combination of Kanamori, Tran., and by taking Official Notice. Applicants respectfully submit that the Examiner is combining references only with the benefit of hindsight facilitated by the claimed invention. In the event it was obvious to one of ordinary skill in the art, one would think that both Kanamori and Tran would have disclosed the claimed invention in its entirety rather than portions of it.

Claims 15, 32 and 33 are dependent upon independent Claim 14, and incorporate all the limitations therein. Hence, Claims 15, 32 and 33 are patentable over Kanamori for the same reasons urged in support of Claim 14. Therefore, the Examiner is requested to withdraw the rejection of claims 14, 15, 32 and 33.

With regard to Claim 24, the rejection alleges that Kanamori discloses a main control unit that controls operation of the telephone device and inherently executed computer instructions which establish the priority between the audio sources as a function of the audio sources and a plurality of outputs and adjust the volume of the signals. Applicants respectfully disagree that Kanamori discloses "establish the priority between the audio sources as a function of the audio sources and a plurality of outputs and adjust the volume of the signals." Kanamori does not teach or suggest adjusting each audio signal as a function of a nature of an output device and a priority rule applicable to each pairing of the audio signals. Claim 24 remains distinct.

Claims 28-30 are dependent upon independent Claim 24, and incorporate all the limitations therein. Hence, Claims 28-30 are patentable over Kanamori for the same reasons advance in support of Claim 24. Therefore, withdrawal of the rejection of Claims 24 and 28-30 is respectfully requested.

The claims are also amended to further emphasize the distinctions from the applied art.

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Conclusion

For all the reasons advanced above, Applicants respectfully submit that the present application is in condition for allowance and that action is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application. Favorable consideration and allowance of the claims pending here is respectfully requested.

Respectfully submitted,

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